

ESTTA Tracking number: **ESTTA682173**Filing date: **07/07/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	33RD COMPANY, INC.		
Entity	Partnership	Citizenship	MINNESOTA
Composed Of:	Thomas R. Sedlack, USA Lynn C. Sedlack, USA		
Address	10451 Glen Eagle Circle Woodbury, MN 55129 UNITED STATES		

Correspondence information	Thomas R. Sedlack General Manager 33RD COMPANY, INC. 10451 Glen Eagle Circle Woodbury, MN 55129 UNITED STATES tomsedlack@33rdcompany.com Phone:651-777-5500 x115
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Applicant Information

Application No	86520772	Publication date	06/16/2015
Opposition Filing Date	07/07/2015	Opposition Period Ends	07/16/2015
Applicant	33rd Republic 230 West Superior Street, 2F #121 Chicago, IL 60654 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2014/07/28 First Use In Commerce: 2014/07/28 All goods and services in the class are opposed, namely: Providing a website for connecting sellers with buyers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3466921	Application Date	11/18/2007
Registration Date	07/15/2008	Foreign Priority Date	NONE
Word Mark	33RD COMPANY		

Design Mark	33RD COMPANY
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Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2002/09/21 First Use In Commerce: 2002/09/21 Real estate agencies

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	33RD COMPANY		
Goods/Services	SERVICES: REAL ESTATE AGENCIES INCLUDING WEBSITES FOR CONNECTING SELLERS WITH BUYERS.		

Attachments	77332495#TMSN.png(bytes) 2015.7.7-33rd Republic Opposition.pdf(787699 bytes) Exhibit A Composite - Definitions.pdf(893683 bytes) Exhibit B Definition in Business English Dictionary.pdf(685609 bytes) Exhibit C Actual Use on Clothing and Apparel.pdf(460164 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/THOMAS R SEDLACK/
Name	Thomas R. Sedlack
Date	07/07/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

33rd Company, Inc., Opposer, v. 33rd Republic Company, Applicant.	Opposition No: _____ In the matter of trademark application Serial No. 86520772 For the mark "33RD REPUBLIC" Published in the Official Gazette on June 16, 2015
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NOTICE OF OPPOSITION

Opposer's Entity Information:

33RD COMPANY, INC.
10451 GLEN EAGLE CIRCLE
WOODBURY, MN 55129 USA

Opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes same. The grounds for opposition are as follows:

I. Opposer is the Owner Valid, Strong, and Legally Protectable Trademark

1. Opposer owns the standard character mark "33RD COMPANY" for "real estate agencies."
2. The mark was granted registration on the principal register by the United States Patent and Trademark Office ("USPTO") on July 15, 2008.
3. On December 30, 2013, the USPTO acknowledged 33rd Company's Declaration of Incontestability for the mark.
4. Opposer's arbitrary use of the ordinal number "33RD" registered in connection with: "real estate agencies" renders the mark strong and deserving of high degree of protection.

Virgin Enters. Ltd. v. Nawab, 335 F.3d 141, 147 (2d Cir. 2003) (“[T]he law accords broad, muscular protection to marks that are arbitrary or fanciful in relation to the products on which they are used”).

5. Given the registration and use of Opposer's strong mark, there is a high likelihood of consumer confusion with the applied-for mark and subject application should be denied. 15 U.S.C. § 1052(d).

II. Likelihood of Confusion

6. The evidentiary factors in determining likelihood of confusion are established in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

7. These factors include the similarity of the marks, the relatedness of the goods and/or services, the channels of trade and classes of purchasers for the goods and/or services, the number and nature of similar marks in use on similar goods, the nature and extent of any actual confusion, and the fame of the prior mark. *Id.*

8. If there is any doubt as to whether there is a likelihood of confusion, that doubt must be resolved in favor of the prior registrant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio), Inc.* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

9. It is well settled that the relevant test is likelihood of confusion, not actual confusion. *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed.Cir.2003). It is unnecessary to show actual confusion to establish likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990).

10. The relevant *DuPont* factors are addressed below:

A. The Applied-for and Registered Marks are Highly Similar in Appearance, Sound, Connotation, and Overall Commercial Impression

i. The Marks have a Similar Appearance

11. Applicant has applied for registration of a stylized mark and Opposer has been using a permissible depiction of its standard character mark in a similar stylization. The two marks are as follows:



Applied-for Mark



Depiction of Opposer's Mark¹

12. The fact that Opposer's mark is registered in standard character form does not avoid likelihood of confusion with the applied-for stylized design because Opposer's mark could be, and is, presented in a very similar manner of display. *In Re Fourth Wall Restaurants, LLC*, 77930437, 2012 WL 3992902, at *4 (Aug. 29, 2012) citing *In re Mighty Tea Leaf*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) and *In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991).

¹ Applicant submitted specimens to the USPTO which displays its mark as AN ILLUSTRATION DRAWING WITH WORD(S)/LETTER(S)/NUMBER(S) IN STYLIZED FORM. The application for Applicant's mark alleges that the date of first use was July 28, 2014. Opposer has used the above-described depiction of its mark at least as early as the time that the original trademark registration in 2008. Use of this depiction of Opposer's mark on a website can be verified early as October 10th, 2011 from public domain sources: <http://web.archive.org/web/20111010211350/http://www.33rdcompany.com/meet-our-staff.html>. Opposer also uses this exact mark on its shirts and polos as well as sweaters to advertise its brand name. It is conceivable that Registrant may attempt to use similar marks on its clothing designs, and thereby cause confusion as to the source of the registrant.

13. If a registrant obtains a standard character mark without claim to “any particular font style, size or color,” the registrant is entitled to depictions of the standard character mark regardless of font style, size, or color, not merely “reasonable manners” of depicting its standard character mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344 (Fed. Cir. 2011). As explained by the court in *Capital City*:

the T.T.A.B. should not first determine whether certain depictions are “reasonable” and then apply the *DuPont* analysis to only a subset of variations of a standard character mark, the T.T.A.B. should simply use the DuPont factors to determine the likelihood of confusion between depictions of standard character marks that vary in font style, size, and color and the other mark...**illustrations of the mark as actually used may assist the T.T.A.B. in visualizing other forms in which the mark might appear.**

Capital City 637 F.3d 1344 at 1353. [emphasis added].

14. Hence the T.T.A.B. should use the above-described depiction of Opposer's mark to assist in visualizing how Opposer's standard character form could be, and is, being used.

15. In addition to the similarities between the applied-for stylization of Applicant's mark and the depiction used by Opposer, it should be noted that in evaluating similarities of marks, if one of the marks comprises both a word and a design, the word is normally accorded greater weight in determining whether the marks are similar because it would be more likely to be impressed upon a purchaser's memory and used by purchasers to request the services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

16. These words and numbers which are to be accorded great weight are highly similar. Indeed, the marks are highly similar when viewed in their entireties in terms of appearance, sound, connotation, and overall commercial impression.

17. Both marks consist entirely of the same ordinal number "33RD" followed by a single word. As used by the parties, the ordinal number "33RD" predominates and is placed above a single word.

18. This identical and arbitrary construction, i.e. an ordinal number followed by a single word far outweighs any dissimilarity resulting from the difference in the single word following the identical ordinal number in each mark.

ii. The Marks have a Similar Connotation and Commercial Impression

19. In addition to the predominant feature of the marks, "33rd," being identical, the respective single words used in each mark, namely, "Company" and "Republic" provides a similar connotation and commercial impression of official groups or entities.

20. The Merriam-Webster online dictionary² defines company, in part, as "the state or condition of being with another person" and defines "republic," in part, as "a body of persons freely engaged in a specified activity." True and correct copies of the definitions are attached hereto and incorporated herein as **Composite Exhibit A.**

21. Thus the connotation and commercial impression of the marks is highly similar.

iii. The Marks have a Similar Sound

² <http://www.merriam-webster.com/> The Merriam-Webster dictionary is a reliable, widely-available print publication and the online version, although not a printed publication, is a widely-known reference that is readily available in specifically denoted editions via the Internet and thus the it is an electronic equivalent of a print publication and applicant may readily verify the excerpt. *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006)

22. In addition to being visually similar and conveying a similar connotation and commercial impression, the marks also sound similar in that the predominating ordinal number "33rd" is pronounced the same way.

23. The marks will sound exactly the same when a shortened reference is used, or spoken, namely "33rd."

24. Any recollection by an average consumer (who would retain a general, rather than specific, impression of trademark), would likely confuse the source of the product or service, or the quality of the similar registrants services with those of the other mark. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

25. Based on the foregoing, Opposer believes that the similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression creates a high likelihood of consumer confusion as to the source of the applicable services.

B. Similarity of Goods and Services

26. Opposer's mark is registered for use in connection with "**real estate agencies**" and Applicant's mark is applied-for in connection with "**providing a website for connecting sellers with buyers.**"

27. The Cambridge Dictionaries Online defines real estate agency as "a business that arranges the selling, renting, or management of homes, land, and buildings for their owners."³ A true and correct copy of the definition is attached hereto and incorporated herein as **Exhibit B**. Clearly, connecting sellers with buyers are predominating terms in each service description.

28. It is settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re International*

³ <http://dictionary.cambridge.org/us/dictionary/business-english/real-estate-agency>

Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

29. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565.

30. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. *Id.*

31. Opposer maintains a website⁴ that connects buyers and sellers as a real estate agency would do by definition.

32. Applicant's alleged provision of a website for connecting sellers with buyer means that both Opposer and Applicant offer a service to consumers in which they are trying to connect buyers and sellers.

33. Applicant's service description is not limited, so it must be construed broadly to include the connecting of buyers and sellers of real estate. *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009).

34. It is the manner in which the Applicant and/or Opposer have identified their goods or services that is controlling. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993).

35. The issue is not whether the actual goods and/or services are likely to be confused but, rather, whether a likelihood of confusion would exist as to the source of the goods and/or

⁴ <http://www.33rdcompany.com/>

services and it is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S (stylized) for retail grocery and general merchandise store services held likely to be confused with BIGGS and design for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) (SEILER for catering services held likely to be confused with SEILER'S for smoked and cured meats); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men's, boys', girls' and women's clothing held likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); *Corinthian Broadcasting Corporation v. Nippon Electric Co., Ltd.*, 219 USPQ 733 (TTAB 1983) (TVS for transmitters and receivers of still television pictures held likely to be confused with TVS for television broadcasting services); *In re Industrial Expositions, Inc.*, 194 USPQ 456 (TTAB 1977) (POLLUTION ENGINEERING EXPOSITION for programming and conducting of industrial trade shows held likely to be confused with POLLUTION ENGINEERING for a periodical magazine).

36. Additionally, under the expansion of trade doctrine, it must be considered whether the goods or services in Applicant's mark are in Opposer's normal fields of expansion. *In re General Motors Corp.* 196 USPQ 574 (TTAB 1977). Providing real estate agency services on a website (as the Opposer already does) is a normal expansion for a real estate agency and thus the identified services for the two marks are related.

37. Accordantly, the similarity of the services in Opposer's and Applicant's marks leads to a high likelihood for consumer confusion.

38. Exhibit C Actual Use on Clothing and Apparel demonstrates one such existing use by Opposer on clothing which is used to promote the brand of Opposer. If the applicant were allowed registration of their mark, it is clearly conceivable that clothing with Applicant's mark could widely penetrate the market, and cause consumer confusion, in addition to the dilution of the Opposer's brand.

C. Similarity in the Channels of Trade and Classes of Purchasers

39. In light of the absence of restriction of trade channels in Opposer's or Applicant's filings, the T.T.A.B. must presume that the services are sold in all the normal channels of trade to the same classes of purchasers, namely ordinary consumers. *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Accordingly, the channels of trade are identical and this factor weighs in favor of granting this Opposition.

D. Number and Nature of Similar Marks

40. The Applicant will not be able to establish that the consuming public is exposed to third-party use of similar marks on similar goods so as to show relative weakness and a narrow scope of protection. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). In fact, the

evidence will show that "33rd Company" and the predominating ordinal number 33rd are unique are rare in the marketplace. Hence, this factor will weigh in the Opposer's favor.

F. Fame of the Prior Mark

41. Opposer manages and maintains over \$250 million in managed real estate in multiple States.

42. As such, Opposer's mark is an established brand and has earned fame in the provision of goods and services.

43. Opposer has additionally demonstrated that the marks are similar.

44. Such similarity in light of the good will and established recognition of Opposer's mark are further reason that the registration be rejected.

III. Request for Denial of Application

Based on the foregoing, there is a high likelihood of consumer confusion between the registered and applied-for marks and Opposer respectfully opposes the registration of the Applicant's mark.

Respectfully submitted this 7th day of July, 2015,

33RD COMPANY



By: Thomas R. Sedlack
Its: Owner | General Manager



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Examples of REPUBLIC

<when asked by a passerby what sort of government the constitutional convention had formulated for the new nation, Benjamin Franklin memorably replied, "A *republic*, if you can keep it">

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Exhibit C Actual Use on Clothing and Apparel

